

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Art Unit: 1642
)	
ANDERSEN, et al.)	Examiner: YU, M.
)	
Serial No.: 10/580,016)	Washington, D.C.
)	
Filed: February 28, 2007)	December 1, 2009
)	
For: PROTEINS BELONGING TO THE)	Docket No.: ANDERSEN=8
BCL-2 FAMILY AND)	
FRAGMENTS THEREOF,...)	Confirmation No.: 7719

ELECTION WITH TRAVERSE

U.S. Patent and Trademark Office
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S i r :

In response to the restriction requirement mailed November 3, 2009, please enter the following response.

1. Applicants elect invention I (claims 10-49 and 61-65) with traverse.

2. The group level restriction is traversed on the following grounds:

The instant application is the national stage of a PCT application, so PCT unity rules apply.

The examiner concedes that claims 1-9, 52 and 58-60 link inventions I-III, and that claim 67 links inventions V-VII.

The group level restriction is procedurally improper because no prior art has been cited against the linking claims.

The examiner concedes that if the claims linking groups I-III are not anticipated by or obvious over the art, that inventions I-III satisfy PCT rule 13.1, that is, they are linked to form a single inventive concept. Under PCT Administrative Instructions, Annex B, paragraph (c), if the independent claims avoid the prior art and satisfy unity of invention, no problem

of lack of unity arises as to any dependent claims.

Restriction is proper against inventions I-III only if a holding of a posteriori lack of unity, based on cited art, can be and has been made. The procedure contemplated by PCT practice is that initially unity is determined on the assumption that the claims avoid the prior art. However, if a search finds prior art that is a basis for rejection, then unity may be reconsidered a posteriori, i.e., after assessment of the prior art. See (c)(ii) and (iii). Since no prior art is applied against the linking claims, the holding of lack of unity among I-III is erroneous.

The Examiner has failed to expressly address group VIII. Group VIII defines a method of use of the composition of linking claim 1. Under PCT administrative Instructions, Annex B, paragraph (e) (1), unity is to be construed to permit inclusion in the same application of both a product claim and a claim for use of that product. Hence, claims 1-9, 52, and 58-60 should be deemed to link not only groups I-III but also group VIII.

Consequently, groups II, III and VIII should be rejoined unless all of the linking claims are held anticipated by or obvious over the prior art.

3. In response to the species restriction on page 4, applicants elect SEQ ID NO:8 and HLA-A2, both with traverse.

4. If group VIII is rejoined, but the conditional species restriction specific to VIII is maintained, applicants elect with traverse that the composition comprises a protein or peptide fragment thereof.

5. The species restrictions are traversed on the ground that the examiner has failed to make a showing of a posteriori lack of unity and hence under PCT administrative instructions (c)(i), since the genus claim presently must be assumed to avoid the prior art, species claims are permissible.

6. Assuming that the group-level restrictions are

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maintained, the linking claims 1-9, 52, 58-60 and 67, and the group I claims 10-49 and 61-65 should be examined.

If the species restrictions are maintained, we must consider which group I claims read on SEQ ID NO:8 and HLA-A2.

According to P15, L27-32, SEQ ID NO:8 is HLA-A2 restricted and Bcl-2 derived.

If species restrictions to both SID 8 and HLA-A2 are maintained, the linking claims and group I claims 10, 11, 13, 16-23, 31-49, and 61-65 should be examined. Note that claims 44-47 use "further comprising" language, and that counsel has assumed that SID 8 satisfies the functional limitations of, e.g., 16-19, 38-40, 42, 43.

Respectfully submitted,

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